

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Patrick J. Sweeney  
Title: METHOD AND DEVICE FOR DELIVERING MEDICINE TO BONE  
Appl. No.: 10/620,287  
Filing Date: 07/15/2003  
Examiner: Koharski, Christopher  
Art Unit: 3763  
Conf. No.: 7722

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**  
**UNDER 37 C.F.R. §1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which was allowed on May 5, 2009.

The Patent Office determined that the patent was entitled to 643 days of PTA. Applicant believes that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicant has recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and has determined that the patent is entitled to 940 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	1106 days
(b) Total Applicant delay:	83 days
Final PTA Determination:	1023 days

Applicant therefore respectfully requests that the patent be accorded 1023 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicant requests further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date May 22, 2009

By /Jeffrey S. Gunderson/

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Docket Number: 029815-0102  
 Application Number: 10/620287  
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	07/15/2003	0		
Edit Delete	Notice to File Missing Parts	10/14/2003	91		
Edit Delete	Response to Notice to File Missing Parts	12/12/2003	150		
	14 month From Application date	09/15/2004	428		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	01/03/2005	538		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	07/06/2006	1,087		
	3 Year Period Starts	07/15/2006	1,096		
Edit Delete	Restriction Requirement	09/11/2006	1,154	(726)	
Edit Delete	Restriction Requirement Response Received at PTO	10/11/2006	1,184		
Edit Delete	Non-Final Office Action	11/01/2006	1,205		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	01/11/2007	1,276		
Edit Delete	IDS under 1.704(c)(8) filed at PTO	02/06/2007	1,302		
Edit Delete	Non-Final Office Action	03/07/2007	1,331		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	05/17/2007	1,402		
Edit Delete	Final Office Action	07/27/2007	1,473		
Edit Delete	Request For Continued Examination	09/26/2007	1,534	(438) 1106	
	3 Year Period Stopped	09/26/2007	1,534		
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	Non-Final Office Action + 3 months	02/26/2008	1,687		
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Edit Delete	Advisory Action	11/14/2008	1,949		
Edit Delete	Request For Continued Examination	11/20/2008	1,955		28
Edit Delete	Non-Final Office Action	02/05/2009	2,032		

Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	03/12/2009	2,067
Edit Delete	Notice of Allowance	05/05/2009	2,121
	Projected Patent Grant Date	11/17/2009	2,317
		Totals:	1,106
		PTA:	1,023
			83



Version: 3.02.05

LOGIN: Carolyn Simpson

IP: 10.50.33.22

Foley &amp; Lardner LLP